

Appl. No.: 09/902,475
Amdt. dated 04/24/2007
Reply to Office action of October 24, 2007

REMARKS/ARGUMENTS

This is a full and timely response to the Final Office Action dated October 24, 2006. Accompanying this amendment is a petition and fee for a three month extension of time extending the response deadline to April 24, 2007. Also filed concurrently herewith is a Request for Continued Examination (RCE) and associated fee. Applicant notes with appreciation the Examiner's thorough examination of the application as evidenced by the Final Office Action.

Prior to the issuance of the present Office Action, Claims 1-21 and 32-44 were canceled without prejudice thereby leaving Claims 22-31 and 45-50 pending in the present reissue application. With the present amendment, Applicant has added Claim 51. Thus, Claims 22-31 and Claims 45-51 are pending in the present application with the entry of the present amendment.

It is respectfully submitted that pending Claims 22-31 and 45-51 are patentable. As such, Applicant respectfully request reconsideration and allowance of the present claims.

Supplemental Declaration

The Examiner has rejected pending Claims 22-31 and 45-50 on the grounds that the claims are based upon a defective reissue declaration under 35 U.S.C. §251. The Applicant has prepared a Supplemental Reissue Declaration that will be signed by the inventors and filed before this reissue application issues.

Recapture Rejection

The present application is a continuation of an application for reissue of U.S. Patent No. 5,968,560 ("the '560 patent"). The parent reissue application, Application No. 09/553,413, has been allowed and the issue fee paid. During prosecution of the parent reissue application, a recapture rejection was asserted. On appeal to the Board of Patent Appeals and Interferences, Appeal No. 2006-0123, the recapture rejection was reversed in a Decision on Appeal mailed February 24, 2006.

During prosecution of the original application, claim 1 was amended to recite mold carriers "which are made in the form of enveloping structures." Claim 1 of the issued '560 patent includes that limitation. Claim 1 recites a device for manufacturing containers; more specifically, a combination of shells, shell holders, and mold carriers. The Board found no recapture in reissue Claim 15, for example, because the limitation on the shape of the mold carriers added to distinguish the prior art also implicitly limited the shape of the shell holders, and that limitation on the shape of the shell holders is retained in Claim 15 directed to the mold assembly subcombination.

In the Office Action mailed October 24, 2006, the Examiner has maintained the recapture rejection asserted against Claims 48-50. Reconsideration of this rejection is requested.

Claims 48-50 and new Claim 51 are directed toward subcombinations, as compared to the combination recited in claim 1 of the '560 patent. Claims 48-50 limit the shape of the mold shells to be "configured to be supported by mold carriers made in the form of enveloping structures via interposed mold shell holders, said mold shell holders being shaped to be supported by said mold carriers made in the form of enveloping structures." Similarly, Claim 51 recites "said mold shells being configured to be supported by mold shell holders shaped to be supported by said mold carriers made in the form of enveloping structures."

The claim limitation added to facilitate issuance of the '560 patent limited the two mold carriers by adding the phrase "which are made in the form of enveloping structures," but also implicitly limited (1) the shape of the shell holders, and (2) the shape of the mold shells – to shapes that can be supported by such enveloping mold carriers. That implicit claim limitation of the mold shells continues to be a required characteristic in claims 48-50 and new claim 51. Because the shape limitation continues to be a required characteristic in the claims 48-51, the Applicants are not recapturing subject matter pertaining to the claimed mold assembly that was surrendered to facilitate issuance of the '560 patent – despite neither the mold carrier nor the mold shell holders being an element of these claims.

In conclusion, all the pending reissue claims, 22-31 and 45-51, include a limitation on one or more claim elements to be configured or shaped to be supported by mold carriers made in the form of enveloping structures. Applying the reasoning of the Board in its Decision on

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Appeal, the Applicants respectfully submit that the present recapture rejection should be withdrawn and the new claim should not provoke a new recapture rejection.




Conclusion

After entry of the requested amendment, claims 22-31 and 45-51 are pending in the present reissue application. In light of the amendments and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable and the application is now in condition for allowance.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,


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